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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/464,039      12/15/99      MEYERS      R      5800-49

000826      HM12/0326  
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EXAMINER

KAUSHAL, S

ART UNIT	PAPER NUMBER
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1633

DATE MAILED: 03/26/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/464,039

Applicant(s)

MEYERS, RACHEL

Examiner

Sumesh Kaushal

Art Unit

1633

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12/15/99.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 61-86 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 61-86 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

*Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

**Polynucleotides**

- I. Claims 61-67 and 72-73, drawn to isolated nucleic acid molecules (**ADH 21620, SEQ ID NO 2**), classified in class 536, subclass 23.1.
- II. Claims 61-67 and 72-73, drawn to isolated nucleic acid molecules (**ADH 33756, SEQ ID NO 4**), classified in class 536, subclass 23.1.
- III. Claims 61-67 and 72-73, drawn to isolated nucleic acid molecules (**ADH 21676, SEQ ID NO 6**), classified in class 536, subclass 23.1.
- IV. Claims 61-67 and 72-73, drawn to isolated nucleic acid molecules (**ADH 21612, SEQ ID NO 8**), classified in class 536, subclass 23.1.
- V. Claims 61-67 and 72-73, drawn to isolated nucleic acid molecules (**ADH 21615, SEQ ID NO 10**), classified in class 536, subclass 23.1.

**Polypeptides**

- VI. Claims 68-70 and 86, drawn to isolated polypeptide (**ADH 21620, SEQ ID NO 1**), classified in class 530, subclass 350.
- VII. Claims 68-70 and 86, drawn to isolated polypeptide (**ADH 33756, SEQ ID NO 3**), classified in class 530, subclass 350.
- VIII. Claims 68-70 and 86, drawn to isolated polypeptide (**ADH 21676, SEQ ID NO 5**), classified in class 530, subclass 350.
- IX. Claims 68-70 and 86, drawn to isolated polypeptide (**ADH 21612, SEQ ID NO 7**), classified in class 530, subclass 350.
- X. Claims 68-70 and 86, drawn to isolated polypeptide (**ADH 21615, SEQ ID NO 9**), classified in class 530, subclass 350.

**Antibodies**

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- XI. Claims 71 and 74-76, drawn to an antibody and method of detecting the polypeptide (**ADH 21620, SEQ ID NO 1**), classified in class 530, subclass 387.1.
- XII. Claims 71 and 74-76, drawn to to an antibody and method of detecting the polypeptide (**ADH 33756, SEQ ID NO 3**), classified in class 530, subclass 387.1.
- XIII. Claims 71 and 74-76, drawn to an antibody and method of detecting the polypeptide (**ADH 21676, SEQ ID NO 5**), classified in class 530, subclass 387.1.
- XIV. Claims 71 and 74-76, drawn to to an antibody and method of detecting the polypeptide (**ADH 21612, SEQ ID NO 7**), classified in class 530, subclass 387.1.
- XV. Claims 71 and 74-76, drawn to to an antibody and method of detecting the polypeptide (**ADH 21615, SEQ ID NO 9**), classified in class 530, subclass 387.1.

**Primers and Probes**

- XVI. Claims 77-79, drawn method of detecting nucleic acid molecules using primers and probes (**ADH 21620, SEQ ID NO 2**), classified in class 536, subclass 24.2.
- XVII. Claims 77-79, drawn method of detecting nucleic acid molecules using primers and probes (**ADH 33756, SEQ ID NO 4**), classified in class 536, subclass 24.2.
- XVIII. Claims 77-79, drawn method of detecting nucleic acid molecules using primers and probes (**ADH 21676, SEQ ID NO 6**), classified in class 536, subclass 24.2.
- XIX. Claims 77-79, drawn method of detecting nucleic acid molecules using primers and probes (**ADH 21612, SEQ ID NO 8**), classified in class 536, subclass 24.2.
- XX. Claims 77-79, drawn method of detecting nucleic acid molecules using primers and probes (**ADH 21615, SEQ ID NO 10**), classified in class 536, subclass 24.2.

**Method of identifying compound that modulates Polypeptide Expression**

- XXI. Claims 80-83, drawn method of identifying compound which binds to the polypeptide and modulates the activity of the polypeptide (**ADH 21620, SEQ ID NO 1**), classified in class 435, subclass 375.
- XXII. Claims 80-83, drawn method of identifying compound which binds to the polypeptide and modulates the activity of the polypeptide (**ADH 33756, SEQ ID NO 3**), classified in class 435, subclass 375.

- XXIII. Claims 80-83, drawn method of identifying compound which binds to the polypeptide and modulates the activity of the polypeptide (ADH 21676, SEQ ID NO 5), classified in class 435, subclass 375.
- XIV. Claims 80-83, drawn method of identifying compound which binds to the polypeptide and modulates the activity of the polypeptide (ADH 21612, SEQ ID NO 7), classified in class 435, subclass 375.
- XXV. Claims 80-83, drawn method of identifying compound which binds to the polypeptide and modulates the activity of the polypeptide (ADH 21615, SEQ ID NO 9), classified in class 435, subclass 375.

**Method of identifying compound that modulates the Nucleic Acid Expression**

- XXVI. Claims 84-85, drawn method of identifying compound which binds to the nucleic acid and modulates the expression of the nucleic acid (ADH 21620, SEQ ID NO 2), classified in class 935, subclass 33.
- XXVII. Claims 84-85, drawn method of identifying compound which binds to the nucleic acid and modulates the expression of the nucleic acid (ADH 33756, SEQ ID NO 4), classified in class 935, subclass 33.
- XXVIII. Claims 84-85, drawn method of identifying compound which binds to the nucleic acid and modulates the expression of the nucleic acid (ADH 21676, SEQ ID NO 6), classified in class 935, subclass 33.
- XXIX. Claims 84-85, drawn method of identifying compound which binds to the nucleic acid and modulates the expression of the nucleic acid (ADH 21612, SEQ ID NO 8), classified in class 935, subclass 33.
- XXX. Claims 84-85, drawn method of identifying compound which binds to the nucleic acid and modulates the expression of the nucleic acid (ADH 21615, SEQ ID NO 10), classified in class 935, subclass 33.

Inventions of Groups I-V (nucleic acid) and VI-X (proteins) are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP 806.05(f)). In the instant case the polypeptide can be isolated from cells endogenously

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expressing the polypeptide, rather than by recombinant means. Thus, these inventions are mutually exclusive and are of separate use.

Inventions are distinct if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP 806.04, MPEP 808.01). Furthermore, inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP 806.05(h)).

In the instant case inventions of Groups I-V, VI-X and XI-XV are drawn to unrelated Nucleic acid sequences, Protein and Antibodies respectively. These inventions are distinct because product as claimed can be used in a materially different process of using that product. For example, the nucleic acid sequence can be used to make expression vectors and genetically engineered host cells, the proteins can be used to modulate cellular growth and antibodies can be use to label cell surfaces. Furthermore, ADH 21612, 21615, 21676 and 33756 nucleic acid, polypeptides antibodies are structurally and functionally distinct product. Therefore, inventions related to these compounds are distinct and are of separate uses.

Furthermore, inventions of Groups XXI-XXV are distinct from inventions of Groups XXVI-XXX because method of modulating the polypeptide expression requires the binding of an agent to the polypeptide, which is distinct from a DNA binding protein or an antisense molecule. In addition, the method of detecting nucleic acid (Group XXVI-XX) requires the use of primers and probes, which has different modes of operation as compared to the method of modulating the polypeptide or nucleotide expression. Thus these inventions are distinct and are of separate uses.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

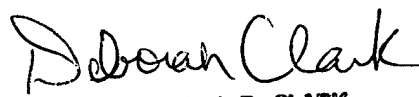
Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(I).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sumesh Kaushal Ph.D. whose telephone number is (703) 305-6838. The examiner can normally be reached on Monday-Friday from 9:00 AM to 5:30 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor Deborah Clark can be reached on (703) 305-4051. The fax-phone number for the organization where this application or proceeding is assigned as (703) 308-4242. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the patent analyst Tracey Johnson, whose telephone number is (703) 308-0377. If the claims are amended canceled and/or added the applicants are advised to follow Amendment Practice under 37 CFR § 1.121 (<http://www.uspto.gov>).

S. Kaushal, AU 1633

  
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